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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Group Art Unit 1644
LOUIS D. FALO, et al. : Examiner: F. Pierre VanderVegt, Ph.D.
Serial No. 09/030,985 : Attorney Docket No. 214001-00648
Filed February 26, 1998 :
Entitled: :
INDUCTION OF TUMOR AND :
VIRAL IMMUNITY USING :
ANTIGEN PRESENTING CELL :
CO-CULTURE PRODUCTS :
AND FUSION PRODUCTS :
:

REQUEST FOR REFUND

November 13, 2000

Assistant Commissioner for Patents
BOX DAC
Washington, DC 20231
ATTENTION: Office of Petitions

Sir:

The above case went abandoned on September 10, 2000, for failure to pay the issue fee. Applicants have filed a Petition to Revive the application, as the application was unintentionally abandoned. Applicants respectfully submit that a mishandling of the captioned case occurred with the Patent and Trademark Office ("PTO"), and therefore request a refund of the cost to revive the application.

The captioned case was filed on February 26, 1998 with 36 claims. The case was subject to a four-way restriction requirement between Group I (Claims 1-12); Group II (Claims 13-24); Group III (Claims 25-30); and Group IV (Claims 31-36). Group II (Claims 13-24) was elected with traverse as to Group IV. More specifically, the Group II claims are directed to formulations or pharmaceutical compositions comprising the products of co-culture of a plurality of antigen-presenting cells and a plurality of either tumor cells or virally infected cells; the Group IV claims are directed to a method of treating a patient using the formulations

or compositions of the Group II claims. As pointed out in response to the Restriction Requirement, pursuant to MPEP § 821.04, if the Group II claims were subsequently found allowable, methods of using the formulations and compositions of those claims (i.e., the claims of Group IV) could be rejoined. The Restriction Requirement was maintained.

In addition to the Restriction Requirement, there was also an election of species requirement as to the antigen-presenting cells and as to a specific species of tumor cells. Appropriate elections were made.

Following prosecution, a Notice of Allowance and Issue Fee Due was received, indicating that Claims 13-15 and 17-24 were allowed. Following receipt of the Notice of Allowance, Applicants telephoned the Examiner to ask why Claim 16 was not indicated as being allowed. Claim 13, which was allowed, is directed to a composition comprising antigen-presenting cells and either tumor cells or virally infected cells; Claim 16 depends from Claim 13, and further defines the virally infected cells. While the Examiner's Amendment treated Claim 16 as being outside the scope of the allowed invention, that action was clearly inconsistent with the substantive reading of the claims, as well as Applicants' Amendment filed on April 13, 2000, in which Claim 16 was amended. Applicants discussed this matter with the Examiner, who conceded that he made a mistake regarding Claim 16. The Examiner further stated that he needed to pull the case back from issuance, that he needed to review the claims as they related to virally infected cells.

Regarding rejoinder of the method claims, Claims 31-36, Applicants specifically requested rejoinder of these claims in the Amendment filed April 13, 2000, even amending Claim 31 to bring it into conformity with the amendments made to the formulation/composition claims. Applicants had no intent to cancel these claims, and also discussed this matter with the Examiner. He further indicated that he would look into the rejoinder issue upon retrieval of the case.

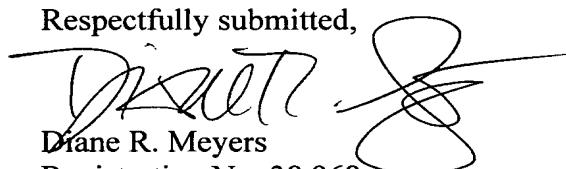
Applicants and the Examiner were in contact over the next several months regarding this matter. The Examiner repeatedly tried to get the case back from various other departments within the PTO, and had even asked his supervisor to intervene, but was unable to get the case back until after abandonment.

Upon receipt of the Notice of Abandonment, Applicants' attorney promptly phoned the Examiner to discuss the matter. The Examiner kindly looked into the situation, and was told that the case was rightfully abandoned for Applicants' failure to pay the issue fee.

Applicants respectfully submit that it is illogical to suggest that they should have paid the issue fee on a case wherein the Examiner conceded he had made a mistake, and wherein the Examiner represented to Applicants that he was having the case withdrawn from issuance. Applicants had the right to rely on the representations made by the Examiner, and had the right to expect that other departments within the PTO would cooperate with the Examiner in this regard. Applicants further submit that payment of the issue fee could have resulted in a significant prejudicing of Applicants' patent rights. For example, payment of the issue fee could have led to issuance of the case as indicated in the Notice of Allowance with a claim that had not been searched as to one aspect. Moreover, if the Examiner had not been given access to the case even after filing of the issue fee, it could have resulted in loss of Applicants' patent rights as to disclosed but unclaimed subject matter; issuance of the patent might also have required the Applicants to file a second case, incurring additional filing, prosecution and maintenance fees.

When the Examiner and an applicant identify an error or omission in a case, the Examiner should have access to the case in order to address the error/omission. Here, the Examiner made every effort to withdraw the case from issuance so the issues could be addressed, but this access was denied. It is respectfully submitted that the Petition to Revive was necessitated by various PTO errors, and Applicants should get a full refund of the Petition fee.

Respectfully submitted,



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